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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,232	06/27/2003	Hitoshi Hagimori	15162/05550	8204

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SIDLEY AUSTIN LLP  
717 NORTH HARWOOD  
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DALLAS, TX 75201

EXAMINER
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SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/609,232	<b>Applicant(s)</b> HAGIMORI ET AL.	
	<b>Examiner</b> Jordan M. Schwartz	<b>Art Unit</b> 2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-14 and 16-26 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-10,12,13,16-24 and 26 is/are rejected.
- 7) ☒ Claim(s) 3,11,14 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Claim Rejections - 35 USC § 112***

Claims 22-23 (and their respective dependent claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 22-23, the claimed "varying distances between all of the lens units" renders the claims vague and indefinite. It is not clear if applicant means "between all of the lens units of the camera" or if applicant means "between all of the plurality of lens units" i.e between all of the claimed plurality (with the latter being the assumed meaning for purposes of examination) and the lack of clarity renders the claims vague and indefinite. It is suggested that applicant amend the claims similar to the amendments of claims 12-13 set forth in applicant's amendment of May 9, 2008

***Claim Objections***

Claims 13, 23, and 26 are objected to for the following reasons. Since the intended meaning could be determined from what is set forth in the specification and figures, 112 rejections were not made but instead these lack of clarity issues are being raised in the following objections.

With respect to claim 13, line 1, after "device" applicant should insert "comprising:" which was apparently inadvertently omitted.

With respect to claims 13, 23, and 26, the claimed third lens unit of "negative" optical power is apparently an inadvertent error and should be

Art Unit: 2873

corrected to of “positive” optical power (the assumed meaning) since in all embodiments and throughout the specification this lens unit is disclosed as positive.

### ***Double Patenting***

Claims 2, 4-10, 12, 16-20, and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/611,016. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

'016 discloses the limitations therein including the following: the limitations of claim 2 ('016, claim 14 and the examiner takes Judicial Notice that right angle prisms with internal reflecting surfaces are well known reflective surfaces used in imaging devices to bend light 90 degrees); the limitations of claim 4 ('016, claim 14); the limitations of claim 5 ('016, claim 14 and it would be obvious to a person of ordinary skill in the art for the lens system of claim 14 to consist of only four lens units since only four lens units are claimed); the limitations of claim 6 ('016, claims 2 and 4); the limitations of claim 7 ('016, claims 2 and 4); the limitations of claim 8 ('016, claims 2, 4 and 8); the limitations of claim 9 ('016, claims 2, 4, and 5); the limitations of claim 10 ('016, claims 2, 4, and 5); the limitations of claim 12 ('016, claims 2 and 4 or claim 14); the limitations of claim 16 ('016, claims 14 and 20 and the examiner takes Judicial Notice that right angle prisms with internal reflecting surfaces are well known reflective surfaces used in imaging devices to bend light 90 degrees); the limitations of claim 17 ('016, claims 2, 4 and 20); the

Art Unit: 2873

limitations of claim 18 ('016, claims 2, 4 and 20); the limitations of claim 19 ('016, claims 2, 4, 8 and 20); the limitations of claim 20 ('016, claims 2, 4, 5, and 20); and the limitations of claim 22 ('016, claims 2, 4, and 20 or claims 14 and 20).

With respect to the condition of independent claims 12 and 22, applicant is claiming a range of 1.5 to 4 and '016 discloses an overlapping range of 2 to 5 as disclosed above. It has been held that where the claimed ranges overlap or lie inside ranges disclosed by the prior art a prima facie case of obviousness exists. *In re Wertheim*, 541 F. 2d 257, 191 USPQ 90 (CCPA 1976).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ

Art Unit: 2873

619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

#### ***Examiner's Comments***

For applicant's information, pursuant to MPEP 804, although application number 10/611,016 is the later filed of the two applications, since it has been allowed and is going to issue it is not "rejectable on other grounds" and therefore the double patenting rejection is appropriate.

Although the claims have been amended in applicant's amendment of May 9, 2008, claims 12 and 22 are essentially the previously presented claims 12 and 22. Specifically, the language of "the second lens unit being disposed next to the first lens unit" is essentially the examiner's presumed meaning of "wherein there is no intervening lens unit or units between the first lens unit and the second lens unit" and since the double patenting rejection is being raised in this office action for the first time, this action is being made non-final.

***Allowable Subject Matter***

Claims 2-14 and 25 are allowed (upon overcoming the double patenting rejection and claim objections set forth above).

Claims 22-23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action (and overcoming the double patenting rejection set forth above).

Claims 16-21, 24, and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims (and overcoming the double patenting rejection set forth above).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is 571-272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
July 28, 2008

/Jordan M. Schwartz/  
Primary Examiner, Art Unit 2873